

REMARKS

The Office Action mailed January 4, 2007, has been received and the Examiner's comments carefully reviewed. In the present response, claims 9, 10, 18, 19, and 29-36 are amended. No new matter has been added by way of these amendments. Favorable reconsideration of this application is requested in view of the following remarks.

Specification

In the Office Action, the disclosure is objected to because (1) it contains an embedded hyperlink, and (2) it contains a trademarked term (i.e. "Intel" on page 9). First, Applicants have deleted the embedded hyperlink on page 16 of the specification to comply with the M.P.E.P. provision cited by the Examiner. Applicants have not deleted the reference to the objected-to term, because it is not used to identify the product; rather, the term "programmable circuit" is used to identify the product, and the objected-to term is used to identify a possible source who manufactures the product. In short, the objected-to term is not used as a descriptive noun, and is therefore allowable based on the language of the M.P.E.P. section (see § M.P.E.P. 601.01(v), p. 600-102 example.) Applicants respectfully request reconsideration and withdrawal of the objections to the specification.

Claim Objections

In the Office Action, claims 9-10 and 18-19 have been objected to because the abbreviation "DRD" should be accompanied with its full form. Claims 9-10 and 18-19 have been editorially revised in accordance with the Examiner's suggestion. Applicants respectfully request reconsideration and withdrawal of this objection to the claims.

Claim Rejections - 35 USC § 101

In the Office Action, claims 29-36 have been rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Examiner states that the claims are directed to non-statutory subject matter because the claims are not limited to tangible embodiments. Applicants respectfully traverse this rejection.

As an initial matter, Applicants respectfully disagree with the Examiner's characterization that a claim need be directed to a tangible embodiment to be within the realm of

statutory subject matter under 35 U.S.C. § 101. Applicants note that the computer program product itself need not be tangible to fall within § 101; rather, the computer program product need only cause a useful, concrete, tangible result. A number of cases issued by the Court of Appeals for the Federal Circuit embrace claims directed to non-tangible media. *See In re Beauregard*, 53 F.3d 1583, 1584 (Fed. Cir. 1995); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998). In fact, the Supreme Court has indicated that statutory subject matter includes “anything under the sun made by man”. *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) The claims as originally presented clearly fall within the statute, as they are directed to a specific, technical effect having a useful result - diagnosing model errors in a software environment.

Nevertheless, and not acquiescing to possible future prosecution of claims encompassing propagated signals, Applicants have amended claims 29-36 to reference a “computer readable storage medium”, recognized in the Office Action as embracing the tangible embodiments of the claims. Applicants therefore assert that even under the narrower interpretation of 35 U.S.C. § 101 applied by the Examiner, claims 29-36 are now directed to statutory subject matter, and are therefore allowable.

For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 29-36. Applicants reserve the right to make further arguments and/or amendments in the prosecution of these claims, including re-introduction of this matter into the specification as applicable under § 101.

Claim Rejections - 35 USC § 103

In the Office Action, claims 1-3, 5-6, 8-13, 15-16, 18-24, 26-32, and 34-36 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Breeden et al. (US Publication No. 2006/0206856) in view of Gove et al. (U.S. Publication No. 2004/0006760). Claims 4, 7, 14, 25, and 33 were rejected under 35 U.S.C. § 103(a) as unpatentable over Breeden et al. in view of Gove et al. and further in view of Kanevsky et al. (U.S. Patent No. 6,167,353). Applicants respectfully traverse these rejections.

For a proper rejection under 35 U.S.C. § 103, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See* MPEP § 2142. With respect to

the rejections based on the combination of Breeden et al and Gove et al., Applicants note that, as presented, independent claims 1 and 12 recite an integrated development environment linked to a run time environment that includes, among other things, “agents that detect failures”, “wherein the failures detected in the run-time environment are traced back to the integrated development environment to determine model errors.” Likewise, independent claims 21 and 29 require “detecting failures within the run-time environment; tracing the failures back to the integrated development environment; and identifying the model errors in the integrated development environment based on the tracing of the failures.” Applicants assert that the combination of Breeden et al. and Gove et al. fails to disclose or suggest the claimed invention.

Neither Breeden et al. nor Gove et al. discloses a system in which errors detected in a run time environment are traced back to a development environment to determine model errors. As the Office Action recognizes, “Breeden does not explicitly disclose whereby the failures detected in the run-time environment are traced back to the integrated development environment to determine model errors.” Office Action, p. 5. Furthermore, the Office Action cites a portion of Gove et al. – “then the developer reviews the performance data and debugs the program” – that describes human debugging of a program, rather than a computer-based system for tracing failures in a run-time environment back to a development environment. Office Action, p. 5. In any case, neither Breeden et al. nor Gove et al. discloses tracing errors back through a link, as disclosed in the present application and recited in the claims. *See generally* p. 22, line 9 to p. 28, line 6.

For at least the above reason, Applicants assert that independent claims 1, 12, 21, and 29 are not rendered obvious by the combination of Breeden et al. and Gove et al. Applicants therefore respectfully request reconsideration and withdrawal of the rejection of these claims.

Claims 2-3, 5-6, and 8-11 depend from claim 1; claims 13, 15-16, and 18-20 depend from claim 12, claims 22-24 and 26-28 depend from claim 21, and claims 30-32 and 34-36 depend from claim 29. These claims inherit all of the limitations of the corresponding independent claims, and therefore are also not rendered obvious by the combination of Breeden et al. and Gove et al. Applicants request reconsideration and withdrawal of the rejections of these claims as well.

Serial No. 10/696,426

Group Art Unit: 2191

With respect to the rejections based on the combination of Breeden et al., Gove et al., and Kanevsky et al., Applicants respectfully observe that Kanevsky et al. also fails to disclose or suggest a system in which errors detected in a run time environment are traced back to a development environment to determine model errors, as discussed above with respect to independent claims 1, 12, 21, and 29. Because claims 4, 7, 14, 25, and 33 depend from these claims and inherit limitations therefrom, these dependent claims are allowable as well. Applicants therefore also request reconsideration and withdrawal of the rejections of these dependent claims.

Conclusion

It is respectfully submitted that each of the presently pending claims is in condition for allowance and notification to that effect is requested. Although certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentably distinct. Applicants reserve the right to raise these arguments in the future. The Examiner is invited to contact Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby.

Respectfully submitted,

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